



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,341	04/20/2001	Takahiro Hayashi	Q64162	1065

7590 12/20/2005
SUGHRUE, MION, ZINN, MCPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,341

Applicant(s)

HAYASHI ET AL.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11, 12, 16, 20, 26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12, 16, 20, 26, 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

A Request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/05 has been entered.

The examiner will address applicant's remarks at the end of this office action. Currently claims 1,11,12,16,20,26,28, are pending.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12,16,20,26,28, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 12,16,20, a mandatory terminal of a transportation vehicle and a server for receiving an order for transportation of an object and a method is being claimed where it is recited that the vehicle is for transporting an object. Now applicant has amended the claims to recite that at least one of said plurality of vehicles is a vehicle mainly for carrying a customer from a boarding place to an alighting place. The newly added language seems to contradict all the other claim language that is reciting

Art Unit: 3629

the fact that the vehicle is for transporting an object. Is at least one vehicle for transporting an object or for carrying people?

Additionally with respect to claims 12,16, is applicant claiming the vehicle and the mandatory terminal or server in this claim? The examiner previously viewed this claim as being directed to just the mandatory terminal and the server (claim 16), but now the newly added language is reciting a feature of the vehicle, so it is not clear if this claim is directed to a combination of the mandatory terminal and the vehicle (and the server and the vehicle) or just the mandatory terminal or server alone.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,11,12,16, are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (6430496).

For claims 1,12,16, Smith discloses a transportation method and system as claimed. Smith discloses a plurality of vehicles 20 that each have their own mandatory terminal. The mandatory terminals of the vehicles have transmission means that allows data/information to be transmitted to and from the order-receiving server 10. The transmission means is shown in Smith as communication link 22 (and 24,18). The

Art Unit: 3629

order-receiving server has a means for receiving and transmitting data/information to and from the mandatory terminals. This means can be interpreted to be 24, 18, and/or 22. The order-receiving server also has means to receive order information from an ordering terminal 14 and to transmit information to the ordering terminal 14. This occurs via communication line 15. The ordering terminal can also transmit information to the server via line 15. Smith also discloses a means to specify the closest vehicle as claimed. See for example, column 8, line 21 ("closest vehicle request"), column 13, lines 41-48 ("N closest vehicles"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). The mandatory terminal, the order receiving server, and the ordering terminals are fully capable of and are disclosed as transmitting and receiving the claimed information. With respect to the language reciting that the order and delivery information include an electronic mail address, this is considered to be non-functional descriptive material that does not serve as a limitation. This limitation is just describing the kind of information being transmitted and does not define anything further to the system itself. The mandatory terminals can transmit information to a customer terminal via the server system 10 and this satisfies the last paragraph of the claim. The control means is interpreted to be the on or off switch that the mandatory terminals will inherently have. The claimed "only in a desired period" is taken to be the working hours of the vehicle. When the terminal is not on, it will not transmit anything and when it is on and the vehicle is in use, the terminal is capable of transmitting.

For claim 11, the examiner does not see how this claim further adds anything to the transportation system of claim 1, other than reciting an intended use of the system. Smith is fully capable of being used by a company with round the clock operation.

For claim 12, in addition to that already set forth by the examiner, the limitation of at least one of said plurality of vehicles is a vehicle mainly for carrying a customer from a boarding place to an alighting place, the examiner does not see what structure this adds to what is being claimed, namely the mandatory terminal or server for receiving an order for a vehicle. This is just reciting an intended use of the vehicles when the claims are directed to either the mandatory terminal or the server and not the vehicles themselves. Smith discloses vehicles and this satisfies what is claimed because the vehicles have the ability to carry people as well as objects. This limitation is found in Smith.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 3629

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 20,26,28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (6430496) in view of Stephens (6323782).

For claims 20,26 Smith discloses the invention substantially as claimed. Smith discloses a transportation method and system as claimed. Smith discloses a plurality of vehicles 20 that each have their own mandatory terminal. The mandatory terminals of the vehicles have transmission means that allows data/information to be transmitted to and from the order-receiving server 10. The transmission means is shown in Smith as communication link 22 (and 24,18). The order-receiving server has a means for receiving and transmitting data/information to and from the mandatory terminals. This means can be interpreted to be 24,18, and/or 22. The order-receiving server also has means to receive order information from an ordering terminal 14 and to transmit information to the ordering terminal 14. This occurs via communication line 15. The ordering terminal can also transmit information to the server via line 15. Smith also discloses a means to specify the closest vehicle as claimed. See for example, column 8, line 21 ("closest vehicle request"), column 13, lines 41-48 ("N closest vehicles"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). The mandatory terminal, the order receiving server, and the ordering terminals are fully capable of and are disclosed as transmitting and receiving

the claimed information. The mandatory terminals can transmit information to a customer terminal via the server system 10. Smith discloses that each vehicle transmits its current location to the server and the server receives this information. A customer transmits ordering information from the ordering terminal to the server. The server can issue a closest vehicle request to located the N closest vehicles to the order location. Once a vehicle is identified that will process the order request the relevant information is transmitted to the vehicle so that the driver knows where to do and what to do. Smith discloses that transportation start and completion information is transmitted as claimed and this data is saved in a file. Applicant is encouraged to read the entire disclosure of Smith but attention is also specifically directed to the following portions of the disclosure: column 11, lines 10-11; column 8, lines 57-61; column 9, lines 36-38; column 4, lines 61-64; column 13, lines 41-48; column 16, lines 38-65; column 17, lines 30- column 18, line 16; column 25, lines 48-64; column 8, line 21 ("closest vehicle request"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). Smith discloses that the customer of the transportation service can be notified of completion of the transportation service via an electronic invoice that does not require postage (see column 21, lines 10-50). This inherently requires the receiving of some address information. Smith does not specifically state that electronic email is used. Stephens discloses a transportation method and system where the customer of a transportation service request is notified of the completion of the request by using electronic email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electronic email as the medium

to transmit the electronic invoice of Smith to the customer as is disclosed by Stephens so that the customer is notified of the completion of the work and how much it cost.

For claim 28, the examiner does not see how this claim further adds anything to the transportation system method of claim 20, other than reciting an intended use of the system. Smith is fully capable of being used by a company with round the clock operation. Reciting the hours a store is open that may utilize the invention of Smith will not be considered a feature that will distinguish over Smith.

8. Applicant's arguments filed 10/24/05 have been fully considered but they are not persuasive.

With respect to the traversal stating that the limitation of "control means for enabling said transmission means to transmit said current location information only in a desired period" is not in the prior art, the argument is non-persuasive. The examiner has addressed this limitation in the rejection and has stated that the control means is considered to be *"the on or off switch that the mandatory terminals will inherently have. The claimed "only in a desired period" is taken to be the working hours of the vehicle. When the terminal is not on, it will not transmit anything and when it is on and the vehicle is in use, the terminal is capable of transmitting."* Applicant is not addressing the rejection as set forth by the examiner. Applicant has made no statement about why the interpretation set forth by the examiner is not correct. The argument is non-persuasive because based on the rejection made by the examiner, Smith discloses what is claimed. Smith inherently has structure that reads on "control means".

With respect to the argument that “at least one of said plurality of vehicles is a vehicle mainly for carrying a customer from a boarding place to an alighting place” is not disclosed in the prior art, this argument is non-persuasive. First, with respect to the article claims 12 and 16, the vehicle and what the vehicle is intended to be used for does not further recite any structure to the mandatory terminal or the server. Additionally, because Smith inherently discloses vehicles and can carry objects or people, the claimed feature is satisfied by the prior art. For the method claim 20, Smith inherently discloses vehicles and can carry objects or people, so the claimed feature is satisfied by the prior art. The vehicles in Smith are fully capable of being used for people or objects. The argument is non-persuasive.

For the 103 rejections, applicant has argued that the “at least one of said plurality of vehicles is a vehicle mainly for carrying a customer from a boarding place to an alighting place” limitation renders the claims allowable. This is non-persuasive for the reasons already set forth by the examiner. The examiner is a little confused as to why applicant would argue that in a method that recites that the use is for transporting an object, applicant would argue that the prior art does not disclose a vehicle that is mainly for transporting people. Doesn't this seem to contradict to method overall in the sense that objects are being recited as for transportation and not people?

Concerning the 103 rejection, the examiner notes that applicant has not presented any rebuttal to the obviousness statement found in the 103 rejection; therefore it is deemed to be proper.

Art Unit: 3629

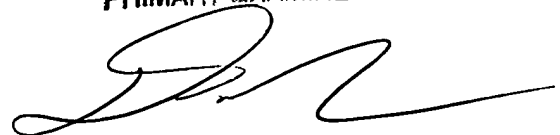
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808.

The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER



DENNIS RUHL
PRIMARY EXAMINER